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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,880	11/26/2001	Yoshiaki Nanko	SN-US015166	3242

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[REDACTED] EXAMINER

MCANULTY, TIMOTHY P

ART UNIT	PAPER NUMBER
3682	

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/991,880	NANKO, YOSHIAKI
	Examiner Timothy P McAnulty	Art Unit 3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 July 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 9 and 10 is/are allowed.

6) Claim(s) 1,2-8 and 11-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1)  Notice of References Cited (PTO-892)

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4)  Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,730,012 to Juy (Juy '012).

Juy '012 discloses in figure 2, a derailleuer comprising a fixed member 1 having a first mounting flange (not numbered) and a second mounting flange (not numbered) wherein said first and second mounting flanges have different axial widths; a first link 4 located within an attachment portion 1b of said fixed member; a second link 3; a third link 2; wherein said second link is coupled via a pivot 18 to said first and second mounting flanges; and a biasing member 12.

As broadly claimed the limitation of "said first mounting flange extending in a rearward axial direction along said second pivot axis relative to said center axis of said curved mounting surface and said second mounting flange extending in a forward axial direction along said second pivot axis relative to said center axis of said curved mounting surface" does not limit the relative location of said first mounting flange and said second mounting flange relative to a longitudinal axis of said curved mounting surface but merely limits that each respective flange to broadly extends in a rearward or a forward direction.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 2-8 and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 3,730,012 to Juy (Juy '012).

Juy '012 discloses the basic apparatus as previously cited but does not disclose the specific dimensional relationships of the elements. However, the actual dimension is merely a matter of engineering design choice and the level of skill of one of ordinary skill in the art would produce a similar optimization, especially absent any evidence to the contrary, i.e. unexpected results.

Furthermore, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (CCPA 1955).

***Allowable Subject Matter***

5. Claims 9 and 10 are allowed.

The prior art discloses or teaches the basic apparatus as previously cited but does not disclose said first pivot axis being spaced farther from a center plane of the chain receiving slot of the chain guide than said second pivot axis.

***Response to Arguments***

6. Applicant's arguments filed 13 July 2003 have been fully considered but they are not persuasive. It is well established that unexpected results must be established with factual evidence. Absent test data comparing the applicants invention to the closest prior art, such arguments are mere assertions of unexpected results. See *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991). The arguments of applicant's representative cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). See also MPEP § 716.01(c). Furthermore, the apparatus of Juy '012 would not be destroyed merely by adjusting dimensions of certain elements to optimum or workable ranges. The modifications to Juy '012 necessary to achieve the claimed limitations would have been obvious to one of ordinary skill in the art.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9326 for regular communications and 703.872.9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.

tpm/JH  
September 16, 2003



DAVID A. BUCCI  
SUPERVISORY PATENT EXAMINER  
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